



OFFICIAL

Docket #33472/1

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Serial No.: 10/633,937

Examiner:

Filed: 08/04/2003

Art Unit: 3629

Confirmation: 5798

**TITLE: BIDDING FOR ENERGY SUPPLY
TO RESELLERS AND THEIR
CUSTOMERS**

INVENTORS: Jack J. Johnson, Madison, NJ
William F. Coyle, Summit, NJ

Commissioner of Patents and Trademarks
P.O. Box 1450
Washington, DC 20231

PETITION TO MAKE SPECIAL UNDER 37 CFR§1.102d

Sir:

The Applicants hereby petition for advancement of the prosecution of the above-entitled Application on the following grounds:

- A. There is an infringing device and method presently in use;
- B. Applicants have made a rigid comparison between the infringing device and method and the claims of the application. In applicants' opinion, some of the claims are unquestionably infringed.
- C. Applicants have made or caused to be made a careful and thorough search of the prior art. The references deemed most closely related to the subject matter encompassed by the claims are listed in Appendix I.

01/16/2004 SMINASS1 00000066 501402 10633937

01 FC:1460 130.00 DA

The search was conducted in Class/Subclass:

705/412, 400, 10,40,34,63

379/112, 115

706/45, 46, 47, 48, 49, 50

D. A detailed discussion of the listed references, pointing out with the particularity required by the 37 CFR § 1.111(b) and (c) how the claimed subject matter is patentable over the references, is attached as Appendix II.

E. In the event that the Examiner considers that the apparatus claims of Group II, set forth below, form a separate invention from the method claims included in the Application, the Applicants elect the method claims of Group I, without traverse, but with a view to the possible filing of the Group II claims in a Divisional Application.

ELECTION OF CLAIMS

The claims are grouped as between method claims and apparatus claims as follows:

Group I (Method Claims)

Claims 1 - 35,
Claims 49 - 95.

Group II (Apparatus Claims)

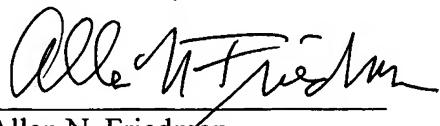
Claims 36 - 48.

Applicants respectfully urge that the above statements and attachments fulfill the requirements of 37CFR §1.102 and MPEP 708.02 and request advancement of the prosecution of this Application.

If, during consideration of this petition, or any ensuing prosecution of the instant Application, the Office considers that a telephone interview would, in any way, advance the prosecution of this Application, the Office is urged to call the undersigned attorney at (973)639-6946.

Respectfully,
Jack J. Johnson
William F. Coyle

By


Allen N. Friedman
Reg. #25,973

Correspondence to:

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McCarter & English, LLP
Four Gateway Center
100 Mulberry Street
Newark, New Jersey 07102
(973) 622-4444

NWK2: 1123421.01
33472-00001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPENDIX I

PATENT REFERENCES

U.S. Patent No. 3,913,829- Fink

Issued October 21, 1975

Filed: May 29, 1974

U.S. Patent No. 5,519,622- Chasek

Issued: May 21, 1996

Filed: October 18, 1993

U.S. Patent No. 5,237,507- Chasek

Issued: August 17, 1993

Filed: December 21, 1990

U.S. Patent No. 5,606,602- Johnson, et al.

Issued: February 25, 1997

Filed: November 6, 1995

U.S. Patent No. 5,790,642- Taylor, et al.

Issued: August 4, 1998

Filed: October 24, 1995

U.S. Patent No. 5,794,212- Mistr, Jr.

Issued: August 11, 1998

Filed: April 10, 1996

U.S. Patent No. 5,894,422- Chasek

Issued: April 13, 1999

Filed: January 27, 1997

U.S. Patent No. 5,930,773- Crooks, et al.

Issued: July 27, 1999

Filed: December 17, 1997

U.S. Patent No. 6,141,653- Conklin, et al.

Issued: October 31, 2000

Filed: November 16, 1998

U.S. Patent No. 6,131,087- Luke

Issued: October 10, 2000

Filed: November 5, 1998

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPENDIX II

STATEMENT OF REASONS FOR PATENTABILITY

A. U.S. Pat. # 3,913,829 - Fink
Issued October 21, 1975
Filed: May 29, 1974
Earliest Priority Date: September 28, 1972

The disclosed system calculates the cost of power generated by cooperating generating companies in order to promote efficient common operation. There is no disclosure or suggestion in the reference of competitive bidding between generating companies.

B. U.S. Pat. # 5,519,622 – Chasek
Issued: May 21, 1996
Filed: October 18, 1993
Earliest Priority Date: October 18, 1993

The disclosed system displays to consumers the present cost of electrical power so that they can efficiently manage their pattern of consumption. There is no disclosure or suggestion in the reference of competitive bidding between generating companies.

C. U.S. Pat. # 5,237,507 – Chasek
Issued: August 17, 1993
Filed: December 21, 1990
Earliest Priority Date: December 21, 1990

The disclosed system computes a demand-related price on an hourly basis by monitoring each consumer's hourly energy usage and the power output of a utility's generators. The system supports inter-utility competitive pricing by posting for every upcoming hour, estimates of each utility's upcoming demand-related price. The system in the reference is cost-demand driven, with no disclosure or suggestion of competitive bidding between utilities.

D. U.S. Pat. # 5,606,602 – Johnson, et al.
Issued: February 25, 1997
Filed: November 6, 1995
Earliest Priority Date: November 6, 1995

The disclosed bidding system for telecommunication traffic, promotes economic decisions, on a call-by-call basis, regarding which carrier should be chosen to carry a call between two points in the telecommunication network. There are many differences between the characteristics of a telecommunication network and an electric power grid so as to make

the two technologies non-analogous. For example, the telecommunication network operates on a point-to-point basis for each call, while the electric power introduced onto the power grid by each utility is indistinguishable, with each consumer tapping off whatever it needs. There is no disclosure or suggestion in the reference of any possible utility of the point-to-point bidding system to the supply of electric power.

E. U.S. Pat. # 5,790,642 – Taylor, et al.
Issued: August 4, 1998
Filed: October 24, 1995
Earliest Priority Date: April 28, 1995

The disclosed system is also in the non-analogous telecommunications field. The system collects bids from service centers desiring to carry a call and assigns the call to the lowest cost center. There is no disclosure or suggestion in the reference of informing a center of what bids are entered by the other centers.

F. U.S. Pat. # 5,794,212 – Mistr, Jr.
Issued: August 11, 1998
Filed: April 10, 1996
Earliest Priority Date: April 10, 1996

The disclosed system promotes more efficient communication between energy suppliers, purchasers, transportation providers and a transportation network administrator. Information from the various partners is entered into a common database. The buyers negotiate purchase transactions and communicate the negotiated transactions to the network administrator. There is no disclosure or suggestion in the reference of a competitive bidding process among suppliers, as claimed in the instant application.

G. U.S. Pat. # 5,894,422 - Chasek
Issued: April 13, 1999
Filed: January 27, 1997
Earliest Priority Date: January 27, 1997

In the disclosed system “smart” electric meters communicate electric power usage information on a time-of-day basis to a central system for a time-of-day billing and to permit load balancing within the power grid. There is no disclosure or suggestion in the reference of a competitive bidding process among suppliers, as claimed in the instant application.

H. U.S. Pat. # 5,930,773 – Crooks, et al.
Issued: July 27, 1999
Filed: December 17, 1997
Earliest Priority Date: December 17, 1997

The disclosed system is a computerized accounting system that receives data on resource usage at a customer’s various sites and makes the information available to the customer by remote viewing from a central database. There is no disclosure or suggestion in

the reference of a competitive bidding process among suppliers, as claimed in the instant application.

I. U.S. Pat. # 6,141,653 – Conklin, et al.
Issued: October 31, 2000
Filed: November 16, 1998
Earliest Priority Date: November 16, 1998

The disclosed system expedites negotiations and iterative bargaining between buyers and sellers. There is no disclosure or suggestion in the reference of a competitive bidding process among suppliers, as claimed in the instant application. Further, the patent's earliest priority date is subsequent to the instant application's earliest priority date.

J. U.S. Pat. # 6,131,087 - Luke
Issued: October 10, 2000
Filed: November 5, 1998
Earliest Priority Date: November 5, 1997

The disclosed system matches offer data from various suppliers with solicitation data from various purchases. Once a best match is identified, the identified prospective buyer and prospective seller are given the opportunity to bargain with each other to the point of negotiating a transaction. There is no disclosure or suggestion in the reference of a competitive bidding process among suppliers, as claimed in the instant application. Further, the patent's earliest priority date is subsequent to the instant application's earliest priority date.

NWK2: 1127408.01
33472-00001



PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL
FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

289

Application Number	10/633,937
Filing Date	08/04/2003
First Named Inventor	Jack J. Johnson
Art Unit	3629
Examiner Name	

Attorney Docket Number

33472/1

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

Petition to Make Special Under CFR 1.102d,
Appendix I, Appendix II
Copies of Cited References

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	McCarter & English, LLP Allen N. Friedman, Esq. Reg. No. 25,973
Signature	
Date	January 12, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Deborah A. Mikolite
Signature	
Date	January 12, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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S E R V I C E

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130.00)

Complete if Known

Application Number	10/633,937
Filing Date	08/04/2003
First Named Inventor	Jack J. Johnson
Examiner Name	
Art Unit	3629
Attorney Docket No.	33472/1

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None
 Deposit Account:

501402

Deposit Account Number
Deposit Account Name
McCarter & English

The Director is authorized to: (check all that apply)

 Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) or any underpayment of fee(s)
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)		(\$ 0.00)	

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims Fee from below	Fee Paid
			-20** = <input type="text"/> X <input type="text"/> =	0.00
			- 3** = <input type="text"/> X <input type="text"/> =	0.00

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2)		(\$ 0.00)

**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

Large Entity

Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	130.00
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 130.00)

(Complete if applicable)

SUBMITTED BY			
Name (Print/Type)	Allen N. Friedman, Esq.	Registration No. (Attorney/Agent)	25,973
Signature	<i>Allen N. Friedman</i>		
	Telephone	973-622-4444	
	Date	January 12, 2004	

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